

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-13 are currently being prosecuted. The Examiner is respectfully requested to reconsider his rejections in view of the amendments and remarks as set forth below.

Allowable Subject Matter

It is gratefully acknowledged that the Examiner considers the subject matter of claims 5, 6 and 9-12 as being allowable if rewritten in independent form. Applicant has not yet rewritten these claims in independent form since they believe that claim 1 from which they depend is allowable.

Rejection under 35 U.S.C. 112

Claims 1-13 stand rejected under 35 U.S.C. 112 as being indefinite. The Examiner objected to the use of the term "chip type". By way of the present amendment, Applicant has removed this language and instead referred to this device as electro-magnetic interference chip device. Applicant believes that this removes the indefiniteness. If this language is not acceptable to the Examiner, Applicant requests the Examiner to suggest language which he feels is suitable. Applicant is willing to remove the word "chip" if the Examiner prefers, although this would cause the claim

to be broadened to include other types of electro-magnetic interference devices.

Rejection under 35 U.S.C. 103

Claims 1 and 3 stand rejected under 35 U.S.C. 103 as being obvious over Sato (USP 5,281,876) in view of Mayumi et al. (USP 4,853,576), Ozaki (JP 407107709) and Haag (USP 6,232,684). This rejection is respectfully traversed.

Applicant submits that claim 1 is not obvious over this four-way combination of references. First, Applicant submits that there is no suggestion of combining all of these various features into one device. Further, Applicant submits there is motivation shown for one skilled in the art to make such a combination. Furthermore, Applicant submits that all of the features are not shown even if these four references are combined.

Claim 1 describes an end cap for a miniature electric motor with the end cap having a body of insulating material and a cover of conductive material and where the body supports two brushes for making sliding contact and with motor terminals in the EMI device having three terminals two of which are input terminals connected to the motor terminals and one of which is an earth terminal connected to the conductive cover. The Examiner suggests that Sato shows a miniature motor with an end cap, a body, two brushes and

two motor terminals. The Examiner further suggests that Mayumi et al. shows an end cap of insulating material with a cover of conductive material. Further, the Examiner states that Ozaki shows a brush holder with an EMI device with three input terminals. He further states that Haag et al. shows an EMI device connected to motor terminals of the motor. However, even if all of these references are combined, there is no teaching that the earth terminal is electrically connected to the conductive cover. Not only is this not present, but the Examiner has not even alleged that it is shown by any of these four references. Accordingly, Applicant submits that claim 1 is allowable over these references even if combined.

Furthermore, Applicant submits that the Examiner has not shown any motivation for making such a combination. It appears that the Examiner is trying to combine pieces from a number of different systems which are not related other than being for electric motors. Applicant requests the Examiner to explain why one skilled in the art would take pieces from these four different devices to make such a combination.

Furthermore, Applicant submits that it would not be obvious to make such a combination. It is only in hindsight that such a combination could be obvious. The Examiner has attempted to combine pieces from different systems. He has not explained why

one skilled in the art would think to add a conductive cover as shown in Mayumi et al. into a device such as shown in Sato. Likewise, the Examiner does not explain why one would add an EMI device as shown in Ozaki or Haag et al. in the Sato device since there is no showing of the need to have one. Accordingly, Applicant submits that this combination is not obvious.

Claim 13 depends from claim 1 and as such is also considered to be allowable. Further, this claim describes the mounting of the EMI device as being on the body of the end cap and accessible from an outer surface. This is not shown in the four-way combination of references and is therefore additionally allowable.

The Examiner rejected claims 2 and 8 as being obvious over the four references discussed above and further in view of Stevenson et al. (USP 5,973,906). Claims 3 and 4 stand rejected under 35 U.S.C. 103 as being obvious over the four-way combination and further in view of Paukovits et al. (USP 4,874,337). Claim 7 stands rejected under 35 U.S.C. 103 as being obvious over the four-way combination and further in view of Burgess et al. (USP 4,845,393). Each of these rejections are respectfully traversed.

The Examiner cited the Stevenson et al. reference to show two earth terminals, the Paukovits et al. reference shows spring connections and the Burgess reference to show a compartment for holding the EMI device. However, even if these references do teach

these features, Applicant submits that these claims are allowable based on their dependency from allowable claim 1. Furthermore, Applicant submits that the Examiner has again shown no motivation for adding a fifth reference to the combination. Applicant submits that the five-way combinations would be even less obvious than the four-way combination discussed above. Applicant requests the Examiner to explain why such a combination would be obvious and what motivation would be present for one skilled in the art considering the piecemeal approach of this combination.

Conclusion

In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination. In view of this, reconsideration of the rejections and allowance of all the claims is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert F. Gnuse (Reg. No. 27,295) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

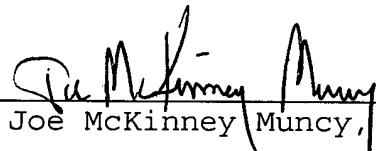
Appl. No. 09/933,008

Pursuant to the provisions of 37 CFR 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Joe McKinney Muncy, #32,334

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

 KM/RFG/jmb
1928-0122P

(Rev. 09/30/03)